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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,554	03/08/2002	Gunter Knoll	GRAT 19.083	5788

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EXAMINER

WINDMULLER, JOHN

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/980,554

Applicant(s)

KNOLL ET AL.

Examiner

John Windmuller

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 4-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3, drawn to a method for cleaving a machine component having a bearing eye, classified in class 225, subclass 2.
  - II. Claims 4-11, drawn to a device for cleaving a machine component having a bearing eye, classified in class 225, subclass 93.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the device of II could be used to practice a method wherein both bearing shells are moved upon breaking.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Harris Wolin on 11/13/03 a provisional election was made without traverse to prosecute the invention of I, a method for cleaving a machine component having a bearing eye, claims 1-3. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4-11 are

withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities: The following terms lack sufficient antecedent basis: Line 6, the term "splitting direction". The terms "cleaving" and "breaking" have also been used. Are these in the same direction as "splitting"? Examiner suggests defining the splitting direction more clearly in the claim. Line 14, "both sides". Which sides are being referred to? Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a

question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1, line 1 recites the broad recitation "a machine component having a bearing eye", and the claim also recites "especially a conrod of a reciprocating piston engine", which is the narrower statement of the range/limitation.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3 are is rejected under 35 U.S.C. 103(a) as being unpatentable over the European reference to Hekman in view of the European reference to Cavallo et al. The method of Hekman discloses the invention as claimed, including, inter alia, the machine component being stuck with its bearing eye onto a two piece split mandrel (Fig. 6, 56, 59) and held fixed on one side of the splitting plane by adjustable stops (Fig. 6, 58), a wedge (Fig. 6, 62) is driven between the two mandrel halves (Fig. 6, 56, 59), splitting the bearing shell into two halves (Fig. 1, 24, 28), making two fractures (Fig. 1, 30, 33) substantially simultaneously, the machine component having been weakened on its

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inside along the intended splitting plain during its manufacture (col. 3, lines 8-12). But Hekman does not teach the bearing eye being subjected to initial stress in the splitting direction by forcing the two mandrel halves apart, and one mandrel half being positionally fixed with the other one moving away from it fixed to the frame. However, Cavallo et al. teach the bearing eye being subjected to initial stress in the splitting direction by forcing the two mandrel halves apart (abstract; Fig. 4, P<sub>2</sub>), and one mandrel half being positionally fixed and the other one moving away from it fixed to the frame (col. 2, lines 21-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the method of Hekman with the bearing eye being subjected to initial stress in the splitting direction by forcing the two mandrel halves apart, and one mandrel half being positionally fixed with the other one moving away from it fixed to the frame as taught by Cavallo et al. to make a cleaner fracture.

### ***Conclusion***


9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Miessen et al. (pre-stress, col. 1-2; claim 5), Hähnel et al. '526 (abstract, one stationary and one mobile jaw), Hähnel et al. '621 (abstract, one fixed and one mobile mandrel), Matsuoka et al. (abstract, generally similar method), Guirgis et al. (pre-stressing, abstract, claim 8).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Windmuller whose telephone number is 703 305-4988. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703 308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-1148.

  
JW

  
Allan N. Shoap  
Supervisory Patent Examiner  
Group 3700